

REMARKS

Claims 1-14 and 21 are pending in the application. Claims 1-14 and 21 have been rejected. No new matter has been added.

Election of Claims

In a January 3, 2006 telephone conversation a provisional election was made with traverse to prosecute the invention of Claims 1-14 and 21. Applicants maintain the election with traverse.

Claims 15-20 are directed to a method of use of an implant inserter of the present invention as set forth in claims 1-14 and 21. The steps of the method relate to the functionality provided by the apparatus of claims 1-14 and 21. The process provided by the Examiner in support of the assertion that the apparatus can be used to practice another and materially different process, namely as a wood router bit, ignores the purpose of the apparatus and the functionality it provides. Indeed, the Examiner's suggested alternative process is from an entirely different classification. The Examiner appears to be selectively reclassifying the apparatus in support of the restriction requirement despite the fact that the Examiner has clearly placed the apparatus and method of use in the same class and subclass.

Accordingly, Applicants respectfully request that the restriction requirement be withdrawn, and that all of the claims presently pending in this application be examined.

Claim Rejections – 35 USC § 102

Claims 1-7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Becker (U.S. Patent No. 2,248,054). Claims 1-4, 7 and 8 are rejected under 35 U.S.C 102(b) as being anticipated by Lutz (U.S. Patent No. 6,183,472). Applicants respectfully traverse the rejections.

Claims 1-7, 9 and 10

Claim 1 is independent. Claims 2-7, 9, and 10 depend from claim 1 and therefore incorporate each and every element of claim 1.

Becker fails to *disclose* each and every element of claims 1-7, 9 and 10. Becker does not disclose an engagement mechanism for selectively engaging *a first portion of the implant* as set forth in the claim 1, of which claims 2-7, 9, and 10 depend. Becker also fails to disclose a shaft movable relative to the engagement mechanism for selectively engaging *a second portion of the implant to rigidify the implant* and for *actuating* the engagement mechanism *to engage with first portion*.

Becker is directed to a screw driver that holds a screw onto the end of the screw driver. In contrast, the present invention addresses two problems: securing the implant onto the end of the instrument and rigidifying the implant for installation. As set forth in the background of the present invention, modern implants are often configured so that the head portion of the implant is pivotable in all direction relative to the shaft portion of the implant (Also see Fig 5 and related description). Because of these movable portions the implants can be difficult to handle thus the components of the implant must be made rigid relative to each other. This is not an issue addressed or even considered in Becker. As such Becker fails to disclose each and every element of claims 1-7, 9, and 10.

Therefore, in view of the arguments set forth above, Applicants respectfully submit that claims 1-7, 9 and 10 are not anticipated by Becker and request that the rejection under 35 U.S.C. 102(b) be withdrawn and the claims passed to issuance.

Claims 1-4, 7 and 8

Claim 1 is independent. Claims 2-4, 7, and 8 depend from claim 1 and therefore incorporate each and every element of claim 1.

Lutz fails to *disclose* each and every element of claims 1-4, 7, and 8. Lutz does not disclose an engagement mechanism for selectively engaging *a first portion of the implant* as set forth in the claim 1, of which claims 2-4, 7, and 8 depend. Lutz also fails to disclose a shaft movable relative to the engagement mechanism for selectively engaging *a second portion of the implant to rigidify the implant* and for *actuating* the engagement mechanism *to engage with first portion*.

Lutz is directed to a pedicle screw and assembly aid that is used to engage an elongated rod into the head of the screw. The assembly aid of Lutz is not for insertion of an implant. The assembly aid disclosed by Lutz has a shank with arms that engage the screw and guide the rod into the head of the screw *which has already been inserted*. As insertion is not addressed, there is no need to deal with the need to rigidify the implant. As such Lutz fails to disclose each and every element of claims 1-4, 7, and 8.

Therefore, in view of the arguments set forth above, Applicants respectfully submit that claims 1-4, 7, and 8 are not anticipated by Lutz and request that the rejection under 35 U.S.C. 102(b) be withdrawn and the claims passed to issuance.

Claim Rejections – 35 USC § 103

Claims 1-14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker (U.S. Patent No. 2,248,054) in view of Lutz (U.S. Patent No. 6,183,472). Applicants respectfully traverse the rejection.

Neither Becker nor Lutz, separately or in combination, teach or suggest each and every element of claims 1-14 and 21. As discussed above in relation to the 102 rejections, neither Becker nor Lutz address the need to rigidify the implant (i.e. fix the shaft portion relative the movably mounted head portion). Neither Becker nor Lutz teach or suggest a shaft movable relative the engagement mechanism (retractable tabs) that rigidifies the implant (fix the shaft portion relative the movably mounted head portion) and actuates the engagement mechanism (retractable tabs). Thus combining Becker with Lutz still fails to teach or suggest each and every element of claims 1-14 and 21.

Therefore, in view of the arguments set forth above, Applicants respectfully submit that claims 1-14 and 21 are patentable over Becker in view of Lutz and request that the rejection under 35 U.S.C. 103 be withdrawn and the claims passed to issuance.

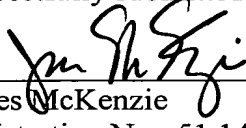
CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

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